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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,242	02/12/2004	Michael R. Friton	005127.00180	2638
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BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER KAVANAUGH, JOHN T	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 12/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/776,242

Applicant(s)

FRITON, MICHAEL R.

Examiner

/Ted Kavanaugh/

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-23 and 30-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-23 and 30-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 7,8,10,11,16,17,19,30,31,33,34 rejected under 35 U.S.C. 102(e) as being anticipated by US 6922917 (Kerns et al).

Kerns teaches footwear having as claimed including a foot-housing member (upper 206), a sole member (202), a closure system (throat cover 210 and canopy 214), wherein the closure system includes a mesh panel (see col. 4, lines 20-32) extending around the foot housing member (upper 206) over a top instep portion from the lateral side to the medial side and the closure system having a securing system (canopy 214 with lace 232 and tightening device 234) with at least two straps (lobes 24).

### ***Claim Rejections - 35 USC § 103***

3. Claims 7,8,10,11,13-17,19,21-23,30,31,33,34,36,37,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4845864 (Corliss) in view of US 5992057 (Monti).

Corliss teaches a foot-receiving device (figure 1-5) comprising a foot-housing member (shoe 20 having a sole 22 and an upper 24), a closure system having a first closure system (flexible outer strap means 54) having a panel (large flexible outer panel 76) which extends over the top instep portion of the foot-housing member and a second closure system (inner strap means 52), and a securing system (end portion 80 of strap means 54 has a VELCRO system 84,86 to secure the closure system to the upper). Corliss lacks the panel being mesh or braided. Monti teaches an outer closure system (shroud 402) being made out of a mesh panel (404). Although Monti only shows the mesh panel extending over the heel area, Monti also teaches the shroud can have a plurality of mesh panels throughout, see col. 3, lines 52-65. It would have been obvious to construct the panel 76 of the closure system (54) of Corliss out of a mesh, as taught by Monti, to further permit the footwear to breath and ventilate itself. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to also construct the closure system of Corliss out of mesh, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding the second closure system being a shoelace based securing system, such systems are old and well known in the art. Therefore, it would have been obvious to substitute the buckle fastening system of the inner strap (52) of the footwear as taught above with a shoelace fastening system inasmuch as substituting one art

recognized fastening means for another is of no apparent patentable criticality and because a number of different fastening means appear suitable.

4. Claims 7,8,10,11,13-17,19,21-23,30,31,33,34,36-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4845864 (Corliss) in view of US 1730768 (Heyman).

Corliss teaches a foot-receiving device (figure 1-5) comprising a foot-housing member (shoe 20 having a sole 22 and an upper 24), a closure system having a first closure system (flexible outer strap means 54) having a panel (large flexible outer panel 76) which extends over the top instep portion of the foot-housing member and a second closure system (inner strap means 52), and a securing system (end portion 80 of strap means 54 has a VELCRO system 84,86 to secure the closure system to the upper). Corliss lacks the panel being mesh or braided. Heyman teaches it has been long known in the art to construct footwear out of braided material, see the entire patent, especially page 2, line 122 to page 3, line 5. Such structure provides a shoe with perforations (i.e. open areas) to provide a light, airy and pleasing appearance. It would have been obvious to construct the panel 76 of the closure system (54) of Corliss out of braids, as taught by Heyman, to further permit the footwear to breath and ventilate itself and a provide a pleasing appearance. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to also construct the closure system of Corliss out of a braided material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its

suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding the strands being made out of plastic, Heyman teaches the strands being “relatively light and pliable material such as paper”, page 1, lines 29-30. It is well known that plastic is also a light and pliable material with much more advantages than paper. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to also construct the strands as taught above out of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Plastic strands would be stronger and more resilient than strands made out of paper.

Regarding the second closure system being a shoelace based securing system, such systems are old and well known in the art. Therefore, it would have been obvious to substitute the buckle fastening system of the inner strap (52) of the footwear as taught above with a shoelace fastening system inasmuch as substituting one art recognized fastening means for another is of no apparent patentable criticality and because a number of different fastening means appear suitable.

Regarding the border around the braided panel, Heyman teaches a border (the trim as shown in figure 3) arranged around the braided structure. Obviously, there has to be an outer border around the braided material or else it would come unbraided. Therefore, it would have been obvious to provide the braided panel of the footwear as taught above with an outer border to prevent the braided material from unbraiding.

Regarding the outer border being made from a different material, it would have been obvious to one having ordinary skill in the art at the time the invention was made to also construct the border out of a different material than the braided panel, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416

5. Claims 9,12,18,20,32,35 are rejected under 35 U.S.C. 103(a) as being unpatentable over references (i.e. Corliss in view of Monti; and Corliss in view of Heyman) as applied to the claims above, and further in view of US 6532687 (Towns et al).

Towns teaches a magnetic fastener arrangement for straps on footwear. It would have been obvious to substitute the VELCRO fastener system as taught above with a magnetic fastener arrangement, as taught by Towns, to provide a fastener that is simple and easy to operate. It would be an obvious design choice to construct the securing system with a magnet fastener arrangement if the wearer was more concerned with a quick and simple closure system over an adjustable system. Moreover, applicant's disclosure reveals that several different types of securing means can be used (see paragraph #22) and therefore this is not patentably critical.

### ***Response to Arguments***

6. Applicant's arguments filed 11-30-2007 have been fully considered but they are not persuasive.

In the process of searching for the newly added claims 38-43, the examiner found a new reference (Kerns) that anticipated some of the claims and therefore a new non-final rejection is given. In the process the examiner also found a better 35 USC 103 rejection and therefore this was also applied. **The examiner reviewed applicant's arguments regarding the last office action and found them not to be persuasive but nonetheless they are now moot in view that the old rejection has been withdrawn.**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. **Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:**

**-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”**

**--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”**

**-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.**

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

/Ted Kavanaugh/  
Primary Examiner  
Art Unit 3728

TK  
December 15, 2007